

### **REMARKS**

In the Office Action mailed September 9, 2002, Claims 1-4, 6, 8, 9, 12 and 13 are rejected under 35 U.S.C. §102(b), as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,274,017 issued to Pan. Claims 1-9, 12 and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,274,017 issued to Pan alone or in view of U.S. Pat. No. 3,130,177 issued to Grabowski.

I. Rejections under 35 U.S.C. §§102(b)/103(a)

Claims 1-4, 6, 8, 9, 12 and 13 are rejected under 35 U.S.C. §102(b), as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,274,017 issued to Pan. Claims 1 and 6 have been cancelled, thus obviating any grounds for rejection based upon those claims. Those claims formerly dependent upon Claim 1 have been amended to depend from Claim 5, which has been rewritten in independent form. Applicants respectfully disagree with the Examiner's contentions regarding Pan.

Applicants remind the Examiner that as stated in MPEP §2131, to anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully contend that the Examiner has failed to point to where Pan does so.

Pan discloses aromatic carbonate polymers containing a metal oxide of different metals, i.e., aluminum, magnesium, lithium, lanthanum, bismuth or yttrium. The reference further discloses that usual additive may be inserted into the composition at col. 7, lines 55-64.

As stated in MPEP §2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed Cir 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed Cir. 1992).

Clearly, there is no such teaching, suggestion or motivation shown in the reference in this case. If the Examiner is relying on knowledge generally available to one of ordinary skill in the art, MPEP §2144.03 states that if applicants traverse such an assertion, the Examiner should cite a reference in support of her position. Applicants do traverse the Examiner's assertion in this case and hereby request such a reference. If the Examiner is relying on facts within her personal knowledge, applicants respectfully request and are calling for, pursuant to MPEP §2144.03 and 37 C.F.R. §1.104, the Examiner to support such facts by an Affidavit.

Therefore, applicants respectfully request the Examiner reconsider and reverse her rejection of Claims 2-4, 8, 9, 12 and 13 under 35 U.S.C. §102(b), as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,274,017 issued to Pan.

## II. Rejections under 35 U.S.C. §103(a)

Claims 1-9, 12 and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,274,017 issued to Pan alone or in view of U.S. Pat. No. 3,130,177 issued to Grabowski. Claims 1 and 6 have been cancelled, thus obviating any grounds for rejection based upon those claims. Those claims formerly dependent upon Claim 1 have been amended to depend from Claim 5, which has been rewritten in independent form. Applicants respectfully disagree with the Examiner's contention regarding the cited art.

Applicants' arguments with respect to Pan as given above are equally applicable to the present rejection. Pan fails to teach or suggest the instantly claimed invention. Further, applicants contend that Grabowski fails to add the missing teaching or suggestion to lead one of ordinary skill in the art to the instantly

claimed invention.

Grabowski relates to the improvement of the thermoplasticity of the polycarbonates and in particular contemplates the blending of polycarbonates with certain graft copolymers containing butadiene, acrylonitrile and styrene at col. 1, lines 20-24. This reference describes the well-known PC/ABS compositions and teaches how to improve the thermoplasticity of polycarbonate.

U.S. Pat. No. 4,450,255 issued to Baney, mentioned by the Examiner at page 3 of the instant Office Action, describes new alumina containing organo-silicone resins that are useful as corrosion inhibiting coatings on metal substrates.

Neither Pan nor Grabowski provide one of ordinary skill in the art with any teaching or suggestion of how to improve the antistatic action and mechanical properties of PC/ABS compositions. Pan mentions aluminum oxide as a flame retardant and Grabowski teaches how to improve the thermoplasticity of polycarbonate.

Therefore, applicants contend that nothing in the teaching of the cited art would lead one of ordinary skill to the instantly claimed invention and respectfully request the Examiner reconsider and reverse her rejection of Claims 2-5, 7-9, 12 and 13 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,274,017 issued to Pan alone or in view of U.S. Pat. No. 3,130,177 issued to Grabowski.

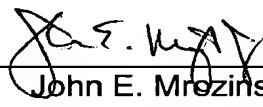
#### CONCLUSION

Applicants have cancelled Claims 1 and 6 and have amended Claims 2-5, 7-9, 12 and 13 and contend that such amendment adds no new matter and finds support in the specification. Attached hereto, please find pages captioned "Version with markings to show changes made."

Applicants submit that the instant application is in condition for allowance. Accordingly, reconsideration and a Notice of Allowance are respectfully requested for Claims 2-5, 7-9, 12 and 13. If the Examiner is of the opinion that the instant application is in condition for other than allowance, she is requested to contact the Applicants' attorney at the telephone number given below so that additional changes to the claims may be discussed.

Respectfully submitted,

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Version with markings to show changes made

IN THE CLAIMS:

The claims have been amended as follows:

2. (Twice Amended) The thermoplastic molding composition according to Claim 45, characterized ~~wherein~~ that the average particle diameter of the compound is 1 nm - 10  $\mu$ m.
3. (Twice Amended) The thermoplastic molding composition according to Claim 45, characterized ~~wherein~~ ~~that said the~~ average particle diameter of the compound is 5 - 500 nm.
4. (Twice Amended) The thermoplastic molding composition according to Claim 45, wherein ~~said the~~ compound is a member selected from the group consisting of oxides, water-containing oxides, phosphates, sulfates, sulfides, sulfites, hydroxides, borates and borophosphates of aluminum.
5. (Twice Amended) The ~~A thermoplastic molding composition according to Claim 1~~ comprising:
  - A. — 40 to 99 parts by wt. aromatic polycarbonate;<sub>i</sub>
  - B. — 0 to 50 parts by wt. vinyl copolymer;<sub>i</sub>
  - C. — 0.5 to 60 parts by wt. graft polymer;<sub>i</sub> and
  - D. — 0.1 to 30 parts by wt. aluminum compound having an average particle diameter of 1 nm - 20  $\mu$ m.
7. (Twice Amended) A thermoplastic molding composition comprising:  
40 to 99 parts by wt. aromatic polycarbonate;

0 to 50 parts by wt. vinyl copolymer;

0.5 to 60 parts by wt. graft polymer which ~~The composition according to Claim 5,~~  
~~wherein graft polymer C is a product of copolymerization of~~

~~\_\_\_\_\_5 to 95 parts by wt. of a mixture of~~

~~\_\_\_\_\_50 to 95 parts by wt. styrene,  $\alpha$ -methylstyrene, styrene substituted on the  
nucleus by halogen or alkyl, C<sub>1</sub>-C<sub>8</sub>-alkyl methacrylate, C<sub>1</sub>-C<sub>8</sub>-alkyl acrylate or  
mixtures thereof, these compounds and~~

~~\_\_\_\_\_5 to 50 parts by wt. acrylonitrile, methacrylonitrile, C<sub>1</sub>-C<sub>8</sub>-alkyl methacrylate,  
C<sub>1</sub>-C<sub>8</sub>-alkyl acrylate, maleic anhydride, C<sub>1</sub>-C<sub>4</sub>-alkyl or phenyl-N-substituted  
maleimide or mixtures thereof these compounds or 5 to 95 parts by weight of  
a polymer having a glass transition temperature below -10°C; and~~

0.1 to 30 parts by wt. aluminum compound having an average particle diameter of  
1 nm - 20  $\mu$ m.

8. (Twice Amended) The thermoplastic molding composition of Claim 4-5 which  
further ~~comprises including~~ at least one additive selected from the group  
consisting of stabilizers, pigments, mould release agents, flow auxiliaries and  
antistatics.

9. (Twice Amended) The thermoplastic molding composition of Claim 4-5 which  
further ~~comprises including~~ at least one additive selected from the group  
consisting of fillers, reinforcing materials and inorganic compounds.

12. (Twice Amended) A In a method of using the molding composition of Claim 4  
~~comprising producing a molded article, the improvement comprising including~~  
the thermoplastic molding composition of Claim 5.

13. (Twice Amended) A The molded article prepared by the method of Claim 12.

As explicitly set forth in 37 C.F.R. Section 1.121(c)(1)(ii), last sentence, a marked up version does not have to be supplied for an added claim or a cancelled claim as it is sufficient to state that a particular claim has been added, or cancelled, and this has been so stated in the Amendment.

In particular, in the instant application, Claims 1 and 6 have been cancelled.